

REMARKS

The Applicants appreciate the Examiner's thorough examination of the subject application. Applicants request reconsideration of the subject application based on the following remarks.

Claims 37-40 and 42-50 are pending in the application and claims 1-36 and 41 were previously cancelled without prejudice.

Claims 37-40 and 42-50 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Fujishima (EP 092628A2) with Rahman (U.S. Patent 6,610,465 B2) in view of Willson (U.S. Patent 6,101,445 A).

The rejection is traversed.

The present invention provides in claim 37, as amended, a photoresist composition that comprises a polymer that comprises a hydroxyadamantyl moiety, a **polymerized norbornene group** and at least two distinct repeat units that each has a photoacid-labile group.

No combination of the cited art teaches or suggests the instantly claimed invention. Moreover, the Office Action has failed to establish a foundation for the allegation that one of ordinary skill in the art would be motivated to combine Fujishima and Willson.

As the reference is understood, Fujishima teaches resins comprising acrylamide, hydroxyadamantylmethacrylate and alkyladamantylmethacrylate monomers. As noted by the pending Office Action, Fujishima neither teaches nor suggests incorporation of norbornene based monomers into the resin composition.

Willson teaches polynorbornene and poly(norbornene-co-malonate) resins and the use of

same for photoresist applications. More particularly, Willson appears to recite that the disclosed polynorbornene resins offer dry etch-resistance and thermal stability.

However, Willson neither teaches nor suggests that the dry etch-resistance and thermal stability of other resins can be increased by incorporation of a norbornene moiety as a co-monomer into the resin formulation.

It is well-known that to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143.

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the cited references to make the claimed invention, nor is there a reasonable expectation of success.

Thus, for at least the reasons recited herein, one of ordinary skill in the art would not have been motivated to combine the disclosure of Fujishima and Willson. Therefore, claim 37 is patentable over the cited art. Claims 38-40 and 42-50 depend from claim 37 and are therefore also patentable over the disclosure of Fujishima and Willson.


In view thereof, reconsideration and withdrawal of the rejection are requested.

It is believed the application is in condition for immediate allowance, which action is

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earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. B. Alexander', written over a horizontal line.

John B. Alexander, Ph.D. (Reg. No. 48,399)
Peter F. Corless (Reg. 33,860)
EDWARDS & ANGELL, LLP
P.O. Box 55874
Boston, MA 02205
Telephone: 617 439 4444